

Appl. No. 10/826,782
Response dated May 20, 2008
Reply to Office action of March 3, 2008

REMARKS/ARGUMENTS

Claims 1-6, 8-12, and 16-21 are pending. Claims 16-18 are rejected.

Claims 7 and 13-15 were previously cancelled without prejudice to filing a continuation with respect thereto.

Claims 1-6, 8-12, and 19-21 stand withdrawn as being directed to a non-elected species.

In this communication, no claims have been amended, canceled or added.

Rejection of Claims 16-18 Under 35 U.S.C. §103.

Claims 16-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,850,453 issued to *St-Germain* (hereafter referred to as “*St-Germain*”) in view of U.S. Pat. No. 3,690,613 issued to *Shoemaker* (hereafter referred to as “*Shoemaker*”), and in further view of U.S. Pat. No. 3,741,516 issued to *Rugger* (hereafter referred to as “*Rugger*”),.

Applicant respectfully traverses the Examiner’s rejection of those Claims under 35 U.S.C. § 103. Specifically, Applicant believes the Examiner has not established a *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure (“MPEP”). The MPEP states,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20

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U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.
MPEP § 706.02(j) (emphasis added).

The Examiner has not shown that all elements of any of claims 16-18 are found in *St-Germain*, or in the combination of *St-Germain*, *Shoemaker*, and *Rugger*. In fact, there is at least one element specified in independent Claim 16 that is not suggested, disclosed, or claimed at all in the cited references.

The Examiner acknowledges that *St-Germain* does not disclose an attachment strap and a retainer body. (3/03/08 Office Action, pg. 2). However, the Examiner contends that *Shoemaker* shows an attachment strap 34 and a retainer body 20. Applicant disagrees with this conclusion and asserts that none of the cited references discloses or suggests a flexible attachment strap as claimed.

Specifically, nothing in *Shoemaker* discloses or suggests a flexible attachment strap. Rather, *Shoemaker* teaches that a rigid tie rod is required to handle compression forces, stating, “In this connection, the tie rod must be strong enough to assimilate the large stresses which are imposed upon it during pouring of wet concrete...” (*Shoemaker*, Col. 1, Lines 47-51)

Similarly, *Rugger* shows a rigid tie rod and tie strap that must handle compression forces. *Rugger* states, “The tie rods and the tie straps 14 in conjunction with the wedge hold the plywood panels in predetermined fixed relation ready to receive concrete.” (*Rugger* 3:44-46). Although not expressly stated by the Examiner, it appears that the Examiner erroneously equates tie

strap with the claimed flexible attachment strap. The specification of *Rugger* discloses the tie strap is “formed of spring steel” so it “may be bent elastically as indicated by dotted lines in Fig. 3”. Clearly, a stiff but ductile spring steel that is required to handle compression forces does not equate to the claimed flexible attachment strap. The Applicant’s specification is not consistent with such an interpretation of the term “flexible”, which states “The strap 102 is preferably formed from a material so that it will be flexible. A preferred material is a plastic, such as nylon.” (¶0050). The specification also teaches away from the use of metal for the strap, stating, “A metal strap will rust, and the rust will stain the wall 12.” (¶0056). A plastic material, such as nylon, can not support the compression forces disclosed in either *Rugger* or *Shoemaker*.

Because the cited references do not disclose a flexible attachment strap, Applicant respectfully submits that the cited references do not suggest or disclose at least one element specifically required by Claims 16-18, and therefore, the Examiner fails to establish a *prima facie* case of obviousness against independent Claim 16-18.

Furthermore, the Examiner has not provided a convincing line of reasoning as to why an artisan would have found the claimed invention obvious. Rather, the Examiner simply cites the prior art references and states the combination of various parts from such references would be obvious, without providing any reasoning or reference as to what motivation, teaching or suggestion would lead an artisan to make any such combination. The MPEP

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clearly states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01.

The case of *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) does not alter the principles set out above based on the facts of the instant invention. There is nothing predictable in and from the prior art relied upon by the Examiner that yields applicant's invention as claimed. “Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 1396. As the above references to the MPEP show, a patent comprised of several elements is not proved obvious merely by demonstrating that each of the elements were independently known in the prior art.

The Supreme Court in *KSR* stated, “Rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” The Examiner has not provided a convincing line of reasoning as to why an artisan would have seen the claimed invention as obvious. Rather, the Examiner simply cites the prior art references and states the combination of various parts from such references would be obvious, without

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providing any reasoning articulated with some rational underpinning or reference as to what motivation, teaching or suggestion would lead an artisan to make any such combination. The MPEP clearly states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01.

The Examiner with benefit of hindsight is picking and choosing pieces from multiple cited references to try to create a device having all the elements of the claimed invention. Using hindsight and an "obvious to try" rational is clearly improper. *In re Dembiczaik*, 175 F.3d 994 (Fed. Cir. 1999); *Yamanouchi Pharmaceutical Co. Ltd. V. Marsam Pharmaceuticals, Inc.*, 231 F.3d 1339 (Fed.Cir. 2000).

Additionally, the Examiner asserts that it would have been "obvious engineering design expediency" to slope the surface of the slots to correspond to the slope of the wedge. However, none of the cited references disclose, teach, or suggest the surface of the slots corresponding to the slope of the wedge. Rather, the Examiner relies on his own personal knowledge and the general knowledge in the prior art to support his obviousness rejection. The Examiner's ability to use such personal and general knowledge is subject to 37 CFR §1.104(d)(2), which states:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when

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called for by the applicant, by an affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." See 37 CFR §1.104(d)(2).

Therefore, Applicant requests under 37 CFR §1.107(b) that the Examiner provide an affidavit in conformance with §1.104(d)(2). Applicant points out that general skill in the art will rarely operate to supply missing knowledge or prior art to reach an obvious judgment. As stated by the Federal Circuit:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Sang Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

In addition, the combination of elements from the cited references would not have been predictable to one of ordinary skill in the art because the cited references teach away from such a combination. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 at 1396 (2007). As discussed above, *Shoemaker* and *Rugger* teach away from a flexible attachment strap. Oppositely, both references disclose rigid or stiff tie rods that are required to withstand compression forces.

Lastly, in response to Applicant's remarks from the Amendment filed December 14, 2007 the Examiner stated:

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"Applicant's arguments filed 12/14/07 have been fully considered but they are deemed not persuasive. Applicant argues that to use a flexible strap with the standoff bracket of St. Germain would be inoperative, the examiner disagrees, the flexible strap is capable of being attached to the dowel of St. Germain and further be capable of being passed through a wall. With respect to Claim 18, note the body of the rejection above."

What Applicant was asserting in the prior paper was that the Examiner's proposed modification to St. Germain (i.e., replacement of the rigid beam 10 and the rigid link member 18 with a flexible member) would render the device of St. Germain inoperable. Specifically, St. Germain only discloses the use of the rigid beam 10 and rigid link 18 to connect the scaffolding to the wall. If this rigid connection between the scaffolding and wall were replaced with a flexible member, as suggested by the Examiner, the scaffolding would become unstable. Unstable scaffolding is dangerous, and hence unusable (or inoperative). Because St. Germain does not teach any other method to stabilize the scaffolding (such as the use of a separate standoff assembly extending between the scaffolding and the wall as set forth in the claims of this application), the modification suggested by the Examiner renders the St. Germain scaffolding inoperative.

To support the conclusion that the claimed invention is directed to obvious subject matter "the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §706.02(j), citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Here, the Examiner has not

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provided a convincing reasoning as to why the proposed modification would be obvious.

Further, Applicant respectfully submits that the Examiner is not using the correct standard in determining making the proposed combination. The Examiner is using an “if the modification can be made” standard. The correct standard is if the proposed modification would be *obvious* to one of skill in the art. 35 U.S.C. 103.¹ As discussed above, the Examiner’s proposed modification would replace a rigid member extending between the scaffolding and the wall with a flexible member. Because the flexible member cannot withstand flexible loads, the scaffolding will become unstable, and thus dangerous to use. One skilled in the art would not make a modification that would render scaffolding unstable. Hence, the Examiner’s proposed modification would not be obvious to one of skill in the art.

In light of the above, Applicant reasserts that Claims 16-18, as set forth in the “Response To Second Restriction Requirement” filed December 17, 2007 are allowable and therefore respectfully requests that the Examiner withdraw the rejection of Claims 16-18 as being obvious under 35 U.S.C. § 103.

¹ 35 USC 103 states that “a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”* (emphasis added)

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You are hereby authorized to charge payment of an extension fee associated with this communication or credit any overpayment to Deposit Account No. 162201.

Respectfully Submitted,

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